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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,707	08/20/2003	Bruce M. Warnes	MP167D1	8473

7590
Edward J. Timmer
Walnut Woods Centre
5955 W. Main Street
Kalamazoo, MI 49009

01/13/2009

EXAMINER

SMITH, FRANCIS P

ART UNIT	PAPER NUMBER
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1792

MAIL DATE	DELIVERY MODE
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01/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/645,707	Applicant(s) WARNES ET AL.	
	Examiner Francis P. Smith	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20,21,26 and 27 is/are pending in the application.
 4a) Of the above claim(s) 1-19 and 22-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,21,26 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments and amendment filed September 26, 2008 have been fully considered but they are not persuasive as outlined below. Claims 1-21 and 22-25 are canceled. Claims 20, 21, 26, and 27 are currently pending and examined on the merits.

Applicants argue the obvious type double patent rejection. Regarding the 6,129,991 reference, applicants argue that the reference teaches a "duplex coating and claim 13 relates to a reactive element that is present in the inner MCrAlY alloy coating and not the outer aluminide diffusion coating in a manner that does not render the pending claims 20 and 21 obvious." However, it is noted that none of the currently pending claims require a reactive element that is located on the outer aluminide diffusion coating as argued. Thus, Applicant's arguments are more narrow than the currently pending claims and are without clear merit.

As per the 5,989,733 reference, it is noted that '733 teaches a chemically vapor deposited aluminide diffusion coating (see claim 1) wherein the coating matrix comprises about 0.01-8 weight percent hafnium and 0.01-2 weight percent zirconium, plus an active element such as yttrium (see claim 2). Therefore, applicants' arguments are apparently without clear merit.

The obvious-type double patent rejections are maintained and outlined below.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 20, 21, 26, and 27 are rejected under 35 U.S.C. 102(a/e) as being anticipated by Murphy (US 6,689,487 B2)

Claims 20, 26, and 27, Murphy teaches a thermal barrier coating comprising:
a coated substrate comprising a superalloy substrate and a chemically vapor deposited aluminide diffusion coating thereon including a coating region a distribution of a reactive elements comprising Hf and/or Zr and Y (col. 3, lines 12-15; col. 8, line 60- col. 9, line 7).

As per claim 21, Murphy teaches a coated substrate further comprising Y (col. 8, lines 60-63).

4. Claims 20, 21, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Warnes et al. (US 6,291,014 B1).

Regarding claims 20, 21, 26, and 27, Warnes teaches a coated substrate comprising a superalloy substrate and a chemically vapor deposited aluminide diffusion coating thereon including a coating modified to include Hf, Zr, and Y (i.e. in a coating regions of the aluminide diffusion coating) (see abstract).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 20-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 13 of U.S. Patent No. 6,129,991. Although the conflicting claims are not identical, they are not patentably

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distinct from each other. '991 and the instant claims differ in that '991 includes nickel as an optional additive. However, it was well known in the art at the time of the invention to include nickel as an additive in diffusion coatings (see abstract of 6,291,014). Therefore it would have been obvious to a person having ordinary skill in the art at the time of the invention to include nickel as a possible additive in the instant invention to achieve the predictable result of forming and aluminide diffusion coating with the reasonable expectation of success.

7. Claims 20-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,7,and 8 of U.S. Patent No. 5,989,733. Although the conflicting claims are not identical, they are not patentably distinct from each other. '733 and the instant claims differ in that '733 includes nickel as an additive. However, it was well known in the art at the time of the invention to include nickel as an additive in diffusion coatings (see abstract of 6,291,014). Therefore it would have been obvious to a person having ordinary skill in the art at the time of the invention to include nickel as a possible additive in the instant claimed coating with the reasonable expectation of success.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis P. Smith whose telephone number is (571) 270-3717. The examiner can normally be reached on Monday through Thursday 7:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mikhail Kornakov can be reached on (571) 272-1303. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. P. S./

Examiner, Art Unit 1792

/Michael Kornakov/

Supervisory Patent Examiner, Art Unit 1792